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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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<u>In re Application, Serial No. 76/572,253</u>)	
TriForest Enterprises, Inc.)	
)	Opposition No. 91165809
Opposer,)	
v.)	
)	
Nalge Nunc International Corporation)	
)	
Applicant-Respondent.)	
_____)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**APPLICANT NALGE NUNC INTERNATIONAL CORPORATION'S
OBJECTIONS TO TRIAL TESTIMONY OF STEVEN LIN AND
MOTION FOR DETERMINATION ADVERSE TO OPPOSER**

I. INTRODUCTION

Applicant Nalge Nunc International Corporation ("Nalge") submits this Motion in accordance with Section 707.03(d) of the Trademark Trial and Appeal Board Manual of Procedure. Nalge objects to certain portions of the trial testimony of Mr. Steven Lin, principal of Opposer TriForest Enterprises, Inc. ("TriForest"). During cross-examination, Mr. Lin refused to answer questions relevant to several critical issues involved in this Opposition. Exacerbating Mr. Lin's refusal to answer these questions was the conduct of counsel for TriForest, who objected to the questions without any resemblance of a good faith basis for doing so. Accordingly, Nalge moves the Trademark Trial and Appeal Board ("Board") for a determination adverse to TriForest related to the questions posed to Mr. Lin.

II. BACKGROUND FACTS

TriForest has alleged, among other things, that Nalge's putative trademark should not be registered due to alleged functional aspects of the mark. TriForest's claims are wholly unsupported, given the fact that (a) there has never existed a utility patent on the whole of Nalge's mark, (b) TriForest has failed to offer a shred of evidence that Nalge touts any utilitarian advantages of the Nalge mark in its advertising, (c) there are numerous third-party, alternative, competitive designs that are functionally equivalent to Nalge's mark, and in fact TriForest offers its own alternative competitive designs, and (d) the method for manufacturing Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle made of the same material. Therefore, each of the Morton-Norwich factors weighs heavily in favor of a determination that Nalge's mark is not functional, and there is no testimony or evidence otherwise.

To further bolster Nalge's position, counsel for Nalge cross-examined Mr. Lin regarding each of the Morton-Norwich factors, including the fourth factor related to the fact that the method for manufacturing Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle made of the same material. In particular, counsel for Nalge cross-examined Mr. Lin regarding the relatively inexpensive costs of manufacturing TriForest's own drinking bottles:

Q Okay. How much does this bottle sell for, Exhibit 19 [TriForest drinking bottle], on a quantity of a thousand or more?

MR. CHENG: If you know.

THE WITNESS: I know, but should I give this information to Nalgene?
That's my --

MR. CHENG: They probably have it.

THE WITNESS: It's -- it's confidential. I don't know Nalgene's cost.

Q BY MR. SCHATZ: Are you refusing to answer the question?

A Yes.

Q I think that's inappropriate, and I'll just make a note for the record. I'm assuming your position is going to be the same with respect to the bottle depicted in Exhibit 20 [another TriForest drinking bottle]? You'll refuse to answer the question as to how much that bottle was sold for?

A Yes.

Q And are you also going to refuse to answer questions related to exactly how much it cost per unit to manufacture those bottles?

A Yes, I refuse that.

MR. CHENG: You already answered those questions, though.

THE WITNESS: I say it's more expensive than the cylindrical bottle.

MR. CHENG: But the precise numbers you are not willing to give.

THE WITNESS: I don't give the precise number.

Q BY MR. SCHATZ: So just to clarify for the record, then, you are going to refuse to answer my questions related to the sales price of the bottles depicted in Exhibits 19 and 20?

A Uh-huh.

Q Correct?

A Correct.

Q And you're also going to refuse to answer my questions related to the cost to manufacture the bottles depicted in Exhibits 19 and 20?

A Yes.

MR. SCHATZ: Just to note for the record, I believe that's completely inappropriate, and we'll go forward. And I'm going to reserve my right to seek that information.

(Trial Testimony of Mr. Steven Lin, at 112:3 – 113:20).¹ Counsel for TriForest, Mr. Clement Cheng, frivolously objected to this line of questioning as seeking confidential information, knowing full well that a Protective Order was already in place to maintain the confidentiality of any information considered confidential. *Id.* at 107:20. Further discrediting Mr. Cheng's objection is the fact that Mr. Cheng lodged Mr. Lin's deposition transcript with the Board without any confidential designation.

III. ARGUMENT

If TriForest can manufacture drinking bottles that are cheaper and simpler to make than products bearing Nalge's mark, then TriForest's allegations of functionality, which are dubious at best, are even more specious. See Morton-Norwich, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982). Therefore, the questions posed to Mr. Lin are directly relevant to the issues involved in this Opposition. Further, due to the Protective Order in place in this Opposition, TriForest's refusal to answer is wholly unjustified.

Section 707.03 of the Trademark Trial and Appeal Board Manual of Procedure addresses the remedy for TriForest's cavalier conduct:

707.03(d) Refusal to Answer Deposition Question

* * *

Accordingly, where the witness in a testimony deposition refuses to answer a particular question...the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony.

Section 707.03(d) expressly provides authority for the Board to presume that the answers to the questions posed to Mr. Lin would have been adverse to TriForest. Prior decisions of the Board are in agreement:

¹ The trial testimony of Mr. Lin was previously lodged with Board.

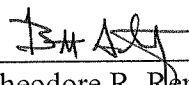
In connection with oral depositions under Rule 2.123, questions are generally answered subject to any objection which has been made. A refusal to answer may, if the objection is not well taken, be construed against the non-answering party. That is, in the event the Board finds that refusal to answer a question was not justified, the Board will presume that the answer to the question would have been adverse to the position of the party whose witness refused to answer.

Health-Tex, Inc. v. Okabashi Corp., 18 U.S.P.Q. 2d 1409 (TTAB 1990); *see also Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q. 2d 1464 (TTAB 1993).

Accordingly, Nalge moves the Board for a determination that Mr. Lin's answers to the questions posed to him by Nalge that he refused to answer would have been adverse to TriForest. Specifically, Nalge requests a determination that the method for manufacturing Nalge's products bearing Nalge's mark is no cheaper or simpler than manufacturing a functionally equivalent drinking bottle. In addition, Nalge requests a determination that the method for manufacturing Nalge's products bearing Nalge's mark is more expensive, complex, and difficult than manufacturing a functionally equivalent drinking bottle, including those offered by TriForest. The requested determination follows directly from Mr. Lin's refusal to _____ answer questions related to the manufacturing costs associated with drinking bottles sold by TriForest.

Respectfully submitted,

Dated: October 20, 2006




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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board on the date shown below.

Date: October 20, 2006

A handwritten signature in cursive script that reads "Anita L. Freeman". The signature is written in dark ink and is positioned above a horizontal line.

Anita L. Freeman

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **APPLICANT NALGE NUNC INTERNATIONAL CORPORATION'S OBJECTIONS TO TRIAL TESTIMONY OF STEVEN LIN AND MOTION FOR DETERMINATION ADVERSE TO OPPOSER** was served by e-file copy and by Federal Express, Two-Day Delivery, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 20th day of October, 2006.

Dated: October 20, 2006